

**REMARKS:**

Claims 1-34 are currently pending in the application. Claims 1-34 stand rejected under 35 U.S.C. § 112, second paragraph. Claims 1-4, 11-14, 21-24 and 31 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,226,618 to Downs et al. ("Downs"). Claims 5, 8, 15, 18, 25, and 28 stand rejected under 35 U.S.C. § 103(a) over Downs in view of U.S. Patent No. 6,343,738 to Ogilvie et al. ("Ogilvie"). Claims 6-7, 16-17, 26-27, and 32-34 stand rejected under 35 U.S.C. § 103(a) over Downs in view Ogilvie and in further view of U.S. Patent No. 6,230,288 to Kuo et al. ("Kuo"). Claims 9, 19, and 29 stand rejected under 35 U.S.C. § 103(a) over Downs in view Ogilvie and in further view of U.S. Patent No. 4,648,047 to Berkland et al. ("Berkland"). Claims 10, 20, 30 stand rejected under 35 U.S.C. § 103(a) over Downs in view of U.S. Patent No. 6,094,722 to Astola et al. ("Astola").

Although the Applicants believe claims 1, 11, 21, and 31-34 are definite, directed to patentable subject matter, and in condition for allowance without amendment. The Applicant has amended claims 1, 11, 21, and 31-34 to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. By making these amendments, the Applicant makes no admission concerning the merits of the Examiner's rejection, and respectfully deny any statement or averment of the Examiner not specifically addressed. Particularly, the Applicant reserves the right to file additional claims in this Application or through a continuation patent application of substantially the same scope of originally filed claims 1, 11, 21, and 31-34. The Applicants respectfully submit that the rejections under 35 U.S.C. § 112 are moot in view of the amendments to the claims. No new matter has been added.

**REJECTION UNDER 35 U.S.C. § 112:**

Claims 1-34 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Specifically, the Office Action maintains that the phrase "not substantially affecting" in claims 1, 11, 21, and 31-34 renders those claims indefinite because it is unclear how exactly the authorized use of data are not being affected. (5 May 2005 Office Action, Page 2). The Applicant disagrees.

Nonetheless, the Applicant has amended independent claims 1, 11, 21, and 31-34 to remove the phrase "substantially" in an effort to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. By making these amendments, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 112, as set forth in the Office Action.

The Applicant submits that independent claims 1, 11, 21, and 31-34 are considered to be in full compliance with the requirements of 35 U.S.C. § 112. The Applicant further submits that independent claims 1, 11, 21, and 31-34 are in condition for allowance.

With respect to dependent claims 2-10, 12-20, and 22-30, claims 2-10 depend from independent claim 1, claims 12-20 depend from independent claim 11, and claims 22-30 depend from independent claim 21. As mentioned above, each of independent claims 1, 11, 21, and 31-34 are considered to be in full compliance with the requirements of 35 U.S.C. § 112. Thus, dependent claims 2-10, 12-20, and 22-30 are considered to be in condition for allowance for at least the reason of depending from an allowable claim. Thus, the Applicant respectfully requests that the rejection of claims 1-34 under 35 U.S.C. § 112 be reconsidered and that claims 1-34 be allowed.

**REJECTION UNDER 35 U.S.C. § 102(e):**

Claims 1-4, 11-14, 21-24 and 31 stand rejected under 35 U.S.C. § 102(e) over Downs.

Although the Applicant believes claims 1-34 are directed to patentable subject matter without amendment, the Applicant has amended independent claims 1, 11, 21, and

31-34 to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. By making these amendments, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 102(e), as set forth in the Office Action.

The Office Action alleges that Downs discloses a system, method and software for watermarking data associated with one or more products. The Applicant has reviewed Downs in detail, particularly looking for a system, method and software for watermarking data associated with one or more products, relied upon by the Examiner. However, Downs fails to disclose each and every limitation recited by claims 1-34. Thus, the Applicant respectfully submits that claims 1-4, 11-14, 21-24 and 31-34 patentably distinguish over Downs.

For example, with respect to amended independent claim 1, this claim recites:

A system for watermarking data associated with one or more products, the system comprising one or more software components collectively operable to:

generate an algorithm for creating a particular pattern in data associated with one or more products available from one or more sellers, the data comprising one or more of product attribute values for each of the one or more products, seller attribute values for each of the one or more products, and product descriptions for each of the one or more products, the data being stored in one or more databases accessible to one or more buyer computers for search queries for data associated with certain of the products, the pattern facilitating identification of a copy of the data and not affecting authorized use of the data by the one or more buyer computers or users associated with the buyer computers; and

apply the algorithm to the data to create the particular pattern in the data. (Emphasis Added).

Amended independent claims 11, 21, and 31-34 recite similar limitations. Downs fails to disclose each and every limitation of amended independent claims 1, 11, 21, and 31-34.

For example, the Examiner asserted that the process for packing content and metadata in Downs corresponds to the generation of an algorithm for creating a particular

pattern in data associated with one or more products. The Applicant respectfully traverses the Examiners assertions regarding the subject matter disclosed in Downs.

The Applicant respectfully submits that Downs does not disclose the generation of an algorithm for creating a particular pattern in data associated with one or more products. Although Downs discloses an ability to extract metadata and to package it for electronic distribution, (Column 9, Lines 15-60), Downs does not disclose, teach, or suggest the generation of an algorithm for creating a particular pattern or even packing content and metadata in data associated with one or more products available from one or more sellers. Thus, Downs cannot provide a system, method, or even software for watermarking data associated with one or more products, since Downs fails to create a particular pattern in data associated with the one or more products from one or more sellers.

Thus, the allegation in the present Office Action that Downs discloses all of the claimed features is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how Downs is considered to anticipate all of the limitations in amended independent claim 1. A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference. MPEP § 2131. The Applicant respectfully points out that "it is incumbent upon the [E]xaminer to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicant respectfully submits that the Office Action has failed to establish a prima facie case of anticipation in amended independent claim 1 under 35 U.S.C. § 102 with respect to Downs because Downs fails to identically disclose every element of the Applicant's claimed invention, arranged as they are in Applicant's claim.

With respect to amended independent claims 11, 21, and 31 each of these claims includes limitations similar to those discussed above in connection with amended independent claim 1. Thus, amended independent claims 11, 21, and 31 are considered patentably distinguishable over Downs for at least the reasons discussed above in connection with amended independent claim 1. Furthermore, dependent claims 2-4 which

depend from amended independent claim 1, dependent claims 12-14 which depend from amended independent claim 11 and dependent claims 22-24 which depend from amended independent claim 21 are also considered patentably distinguishable over Downs. Thus, dependent claims 2-4, 12-14, and 22-24 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for the reasons set forth herein, the Applicant submits that claims 1-4, 11-14, 21-24 and 31 are not anticipated by Downs. The Applicant further submits that claims 1-4, 11-14, 21-24 and 31 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 1-4, 11-14, 21-24 and 31 under 35 U.S.C. § 102(e) be reconsidered and that claims 1-4, 11-14, 21-24 and 31 be allowed.

#### **THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:**

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. **Prior Knowledge**: The invention was publicly known in the United States before the patentee invented it.
2. **Prior Use**: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
3. **Prior Publication**: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
4. **Prior Patent**: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.

5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.
4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the Claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any



commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

**REJECTION UNDER 35 U.S.C. § 103(a):**

Claims 5, 8, 15, 18, 25, and 28 stand rejected under 35 U.S.C. § 103(a) over Downs in view of Ogilvie. Claims 6-7, 16-17, 26-27, and 32-34 stand rejected under 35 U.S.C. § 103(a) over Downs in view Ogilvie and in further view of Kuo. Claims 9, 19, and 29 stand rejected under 35 U.S.C. § 103(a) over Downs in view Ogilvie and in further view of Berkland. Claims 10, 20, 30 stand rejected under 35 U.S.C. § 103(a) over Downs in view of Astola.

Although the Applicant believes claims 1-34 are directed to patentable subject matter without amendment, the Applicant has amended independent claims 1, 11, 21, and 31-34 to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. By making these amendments, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Applicant respectfully submits that Downs, Ogilvie, Kuo, Berkland, or Astola either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 5-10, 15-20, 25-30, and 32-34. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of claims 1-28 under 35 U.S.C. § 103(a) over the proposed combination of Downs, Ogilvie, Kuo, Berkland, and Astola either individually or in combination.

For example, with respect to amended independent claim 1, and dependent claims 5 and 8, these claims recite:

A system for watermarking data associated with one or more products, the system comprising one or more software components collectively operable to:

generate an algorithm for creating a particular pattern in data associated with one or more products available from one or more sellers, the data comprising one or more of product attribute values for each of the one or more products, seller attribute values for each of the one or more products, and product descriptions for each of the one or more products, the data being stored in one or more databases accessible to one or more buyer computers for search queries for data associated with certain of the products, the pattern facilitating identification of a copy of the data and not affecting authorized use of the data by the one or more buyer computers or users associated with the buyer computers; and

apply the algorithm to the data to create the particular pattern in the data;

wherein the algorithm is a sifting function; and

wherein the pattern comprises a plurality of insertion, deletions, or modifications of printable American Standard Code for Information Interchange (ASCII) characters in the data according to a pre-defined arrangement. (Emphasis Added).

Dependent claims 15, 18, 25, and 28 recite similar limitations. Downs or Ogilvie either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 5, 8, 15, 18, 25, and 28.

The Applicant respectfully submits that the Office Action acknowledges, and Applicant agrees, that Downs fails to disclose the emphasized limitations noted above in dependent claims 5 and 8. Specifically the Examiner acknowledges that Downs fails to teach the algorithm is a sifting function or that Downs fails to teach the pattern including a plurality of insertion, deletion, or modifications or printable ASCII characters in data according to a predefined arrangement. (5 May 2005 Office Action, Pages 4-5). However, the Examiner asserts that the cited portions of Ogilvie disclose the acknowledged shortcomings in Downs. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in Ogilvie.

The Applicant respectfully submits that Ogilvie has nothing to do with dependent claim 5 and 8 limitations regarding (1) an algorithm for creating a particular pattern in data associated with one or more products available from one or more sellers that is

sifting function and (2) a particular pattern in data associated with one or more products comprising plurality of insertion, deletion, or modifications of printable ASCII characters in data according to a predefined arrangement. Rather Ogilvie discloses a technique for facilitating transactions involving digital goods through a broker. (Abstract). Ogilvie merely discloses a sampling technique based on content types which may include ASCII text. Ogilvie does not disclose: (1) a sifting function associated with an algorithm for creating or even sampling a particular pattern in data associated with one or more products or (2) a pattern in data associated with one or more products according to a predefined arrangement. Thus Ogilvie cannot provide a system, method, or even software for watermarking data with one or more products comprising one or more software components collectively operable to generate an algorithm for creating a particular pattern in data associated with one or more products available from one or more sellers that is sifting function or a pattern in data associated with one or more products comprising plurality of insertion, deletion, or modifications of printable ASCII characters in data according to a predefined arrangement.

The Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Downs or Ogilvie, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Downs to include: (1) a sifting function for better protecting the products from unauthorized access and (2) a plurality of insertion, deletion, or modifications of printable ASCII characters in data according to a predefined arrangement as taught by for better protecting the products from unauthorized access.

The Applicant further submits that these purported advantages relied on by the Examiner of better protecting the products from unauthorized access are nowhere disclosed, taught, or suggested in Downs or Ogilvie either individually or in combination. The Applicant respectfully requests the Examiner to point to the portions of Downs or

Ogilvie which contain the teaching, suggestion, or motivation to combine these references for the purpose of better protecting the products from unauthorized access. A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. Id. at 1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of Downs or Ogilvie either individually or in combination.

The Applicant respectfully submits that the Office Action further acknowledges, and Applicant agrees, that Downs fails to disclose the emphasized limitations in dependent claims 6-7, 9, 10, 16-17, 19, 20, 26-27, 29, 30 and amended independent claims 32-34. Specifically the Examiner acknowledges that Downs fails to teach: (1) the pattern including inserting non-printable ASCII characters throughout the data according to pre-defined arrangement; (2) the pattern comprises each instance of a particular group of characters in the data being underscored throughout the data; and (3) determining a first sum of numerical values of bytes representing the data stored in the one or more databases for later comparison with a second sum of numerical values of bytes representing data from another source to determine whether the data from the other source is a copy of the data from the one or more databases. (5 May 2005 Office Action, Pages 5-8). However, the Examiner asserts that the cited portions of Ogilvie, Kuo, Berkland, or Astola disclose the acknowledged shortcomings in Downs. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in Ogilvie, Kuo, Berkland, and Astola.

The Applicant respectfully submits that Ogilvie, Kuo, Berkland, or Astola has nothing to do with dependent claim 6-7, 9, 10, 16-17, 19, 20, 26-27, 29, 30 and amended independent claim 32-34 limitations regarding (1) the pattern including inserting non-printable ASCII characters throughout the data according to pre-defined arrangement; (2) the pattern comprises each instance of a particular group of

characters in the data being underscored throughout the data; and (3) determining a first sum of numerical values of bytes representing the data stored in the one or more databases for later comparison with a second sum of numerical values of bytes representing data from another source to determine whether the data from the other source is a copy of the data from the one or more databases.

As mentioned above, Downs fails to disclose, teach, or suggest a generation of an algorithm for creating a particular pattern in data associated with one or more products available from one or more sellers and the data being stored in one or more databases accessible to one or more buyer computers for search queries for data associated with certain of the products, the pattern facilitating identification of a copy of the data and not affecting authorized use of the data by the one or more buyer computers or users associated with the buyer computers. Thus, the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Downs, Ogilvie, Kuo, Berkland, or Astola, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Downs for better protecting the products from unauthorized access.

The Applicant respectfully submits that these purported advantages relied on by the Examiner of better protecting the products from unauthorized access are nowhere disclosed, taught, or suggested in Downs, Ogilvie, Kuo, Berkland, or Astola either individually or in combination. The Applicant respectfully requests the Examiner to point to the portions of Downs, Ogilvie, Kuo, Berkland, or Astola which contain the teaching, suggestion, or motivation to combine these references for the purpose of better protecting the products from unauthorized access. A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. In *re Lee*, 61 U.S.P.Q.2d

1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of Downs, Ogilvie, Kuo, Berkland, or Astola either individually or in combination.

With respect to amended independent claims 32-34 each of these claims includes limitations similar to those discussed above in connection with amended independent claim 1. Thus, amended independent claims 32-34 are considered patentably distinguishable over the proposed combination of Downs, Ogilvie, Kuo, Berkland, and Astola for at least the reasons discussed above in connection with amended independent claim 1.

With respect to dependent claims 5-10, 15-20, and 25-30, claims 5-10 depend from amended independent claim 1, claims 15-20 depend from amended independent claim 11, and claims 25-30 depend from amended independent claim 21. As mentioned above, each of amended independent claims 11 and 21 includes limitations similar to those discussed above in connection with amended independent claim 1. Thus, amended independent claims 11, 21, and 31 are considered patentably distinguishable over Downs for at least the reasons discussed above in connection with amended independent claim 1. Thus, dependent claims 5-10, 15-20, and 25-30 are considered patentably distinguishable over the proposed combination of Downs, Ogilvie, Kuo, Berkland, and Astola for at least the reasons of depending from an allowable claim and are therefore considered to be in condition for allowance.

For at least the reasons set forth herein, the Applicant submits that claims 5-10, 15-20, 25-30, and 32-34 are not rendered obvious by the proposed combination of Downs, Ogilvie, Kuo, Berkland, and Astola. The Applicant further submits that claims 5-10, 15-20, 25-30, and 32-34 are not rendered obvious by the proposed combination of Downs, Ogilvie, Kuo, Berkland, and Astola are in condition for allowance. Thus, the Applicants respectfully request that the rejection of claims 5-10, 15-20, 25-30, and 32-34 under 35 U.S.C. § 103(a) be reconsidered and that claims 5-10, 15-20, 25-30, and 32-34 be allowed.

## **THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.



**CONCLUSION:**

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

7/12/05  
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